

REMARKSA. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the specification, the amendments to the claims and the following remarks.

B. Election

A restriction requirement had been put forward between Group I, claims 1-6, drawn to toners, and Group II, claims 7-20 drawn to image forming methods. The undersigned had made a provisional election with traverse to prosecute Group I.

Applicants affirm the election of Group I. However, Applicants wish to traverse the restriction requirement since the claims of Group II directed to a use of the toner should be subject to rejoinder after the claims of Group I directed to the toner itself are allowed. Thus, it is respectfully asserted that the restriction requirement is improper in this instance.

C. The Invention

The present invention is directed to a toner having specified values for volume average particle diameter, arithmetic mean value of shape factor, coefficient of variation of shape factor, ratio of rounded toner particles, coefficient of variation of number particle diameter and conveyance index. Image forming methods of utilizing the toner are also claimed.

In one of the novel aspects of the invention, external additives are added to the toner to adjust the conveyance index within the claimed range. The Inventors have surprisingly discovered that adjusting the conveyance index within the claimed range prevents dusting or fogging during image transfer thereby generating sharp images and preventing non-uniform image density, white stream noise and reduction in image density (page 17, lines 9-26).

D. Claim Amendments

Claims 1-20 were original claims in this application, claims 7-20 having been withdrawn from consideration subject to the traversal discussed in paragraph B above.

This amendment adds new claims 21-34. Claims 1-6 and 21-34 are therefore presented for further prosecution.

Claim 1 has been amended to delete the language relating to the intended use of the toner.

Claims 21-28 have been added to further define the toner of claim 1. Independent claims 29 and dependent claims 30-34 have been added to mirror claims 1-6 and 21-28 and are directed to a single component developer. Support for these new claims can be found as follows:

Claims 21 and 22 - page 17, lines 5-8;

Claim 23 - page 27, lines 17-22;

Claim 24 - page 27, lines 23-25;

Claim 25 - page 28, lines 24-26;

Claim 26 - page 31, lines 15-18;

Claim 27 - page 17, lines 5-8

Claim 28 - page 49, lines 9-14;

Claim 29 - page 67, lines 23-25 and claim 1;

Claim 30 - page 25, line 22 to page 26, line 1;

Claim 31 - page 28, lines 24-26;

Claim 32 - page 31, lines 15-18;

Claim 33 - page 17, lines 5-8; and

Claim 34 - page 41, lines 3-25 and page 42, lines 11-12.

E. Rejection under 37 CFR 1.84(p) (5)

Figure 5 had been objected to for failing to describe reference character 493 in the specification.

At page 79, lines 5-15, the limiting member and discharging member of Figure 5 had both inadvertently been given reference character 492. Applicants have amended page 79 to give the discharging member reference character 493. It is deemed that the rejection should be removed.

F. Objections to the Disclosure

The disclosure had been objected to for referring to trademarks without capitalization. Applicants have reviewed the entire specification as suggested by the Examiner and have amended numerous portions of the specification as correction.

G. Rejections under 35 USC § 102(b) and § 103(a)

Claims 1-5 had been rejected as being anticipated by, or in the alternative, as being unpatentable over Kohyama (US 2002/0037469).

Kohyama had been cited to teach toner particles having the claimed volume average particle diameter, arithmetic mean value of shape factor, coefficient of variation of shape factor, ratio of rounded toner particles, coefficient

of variation of number particle diameter and conveyance index. With regard to the conveyance index, the Examiner had presumed that Kohyama inherently meets this limitation, since Kohyama meets the compositional limitations of the invention (page 12, line 7 to page 13, line 13 of the Office Action).

1. The conveyance index is not a direct function of the compositional limitations of the toner

As explained at page 25, lines 1-12 of the Application, the conveyance index of the toner varies by adding external additives according to a specific mixing technique. Exemplary methods of mixing the additive are explained at page 94, line 3 to page 95, line 8 and are designated "Methods 1 to 4".

As illustrated in Table 3 at page 96, mixing Methods 1 to 4 have a direct effect on the conveyance index of the toner. For example, Toners K1-K5 mixed with different mixing methods have different conveyance indices, even though they are each composed of the same colorant particle K1. Thus, Table 3 demonstrates that the Examiner's presumption of the conveyance index being directly related to the compositional limitations of the toner is incorrect.

2. Kohyama does not inherently teach the claimed conveyance index

The Examiner had cited toner 10BK in paragraphs 0376 and 0413 of Kohyama to teach the toner of the invention. The cited paragraphs teach that silica and titanium are added to the toner and are mixed using a Henschel mixer, however, a specific mixing technique is not disclosed.

In order to maintain an inherency rejection under § 102(b), it must be made clear that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.", MPEP § 2112(IV), citing *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

As discussed in section 1 above, the mixing methods of the additives is significant to control the conveyance index. The cited sections of Kohyama, as well as Kohyama as a whole, do not teach or suggest adding the external additives under any specific mixing methods to adjust the conveyance index. Kohyama therefore does not inherently teach adjusting the conveyance index within the range of claim 1, since the conveyance index cannot be "necessarily

present" in Kohyama due to the fact that Kohyama is silent with respect to the mixing methods of the additives.

Applicants respectfully submit that Kohyama does not inherently teach the conveyance index of the invention as required to maintain the anticipation rejection.

3. It would not be obvious to achieve the present invention based on the teachings of Kohyama

The mixing methods of the external additives play a significant role in adjusting the conveyance index of the invention as explained above. Kohyama makes no mention of the mixing methods of the external additives. Thus, it would not be obvious to achieve the present invention based on the teachings of Kohyama.

It is respectfully submitted that the present invention is not obvious over Kohyama.

H. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are

hereby made and authorization is given to debit Account #
02-2275.

Respectfully submitted,

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February 22, 2005

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